UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,976	01/30/2004	Keith V. Wood	341.020US1	6271

21186 7590 08/01/2006

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
KOSSON, ROSANNE	

ART UNIT	PAPER NUMBER
1653	

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/768,976	WOOD ET AL.	
	Examiner	Art Unit	
	Rosanne Kosson	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *35-44,46-51,55,56,58,64-67,69-77,107 and 109-120* is/are pending in the application.

4a) Of the above claim(s) *35-44,46-51,55,56,58,64-67 and 69-77* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *107 and 109-120* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The amendment filed on July 11, 2006 has been received and entered. Claims 107, 110 and 120 have been amended. Claims 1-34, 45, 52-54, 57, 59-63, 68, 78-106 and 108 have been canceled. No claims have been added. Claims 35-44, 46-51, 55, 56, 58, 64-67 and 69-77 were previously withdrawn as being drawn to non-elected inventions. Accordingly, claims 107 and 109-120 are examined on the merits herewith. The finality of the previous Office action has been withdrawn in order to present additional rejections to the pending claims.

Claim Objections

Because of Applicants' claim cancellations, the objections to claims 5, 9, 108 and 109 are moot and are withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Because claims 1-3, 5-11 and 15 have been canceled, the rejection of these claims in the previous Office action is moot and is withdrawn.

Claims 107 and 109-120 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 107, 110 and 120 recite a "divalent" branched or unbranched carbon chain. A divalent carbon chain is not defined in the specification, rendering the meaning of the claims unclear. Appropriate correction is required. The term "divalent" may be deleted.

Claim 109 is undefined because the terms R, A and X are not defined in the specification or in the claim. The definition of these terms must appear in the claim, as in claim 110. These three moieties can be anything. The specification provides examples of these terms (see pp. 5 and 52-55), but not definitions. Therefore, the metes and bounds of the claim are unclear and cannot be determined. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 109 is rejected under 35 U.S.C. 102(b) as being anticipated by Stryer, Biochemistry, 3d Ed., W. H. Freeman and Co., New York, 1988, pp. 757-758. Stryer discloses the mechanism of chain elongation in protein translation. In these reactions, an activated ester containing functional groups (an aldehyde group, an amino group and t-RNA) reacts with an amine containing A and X groups, which can be anything, such as spacer atoms, side-chain groups and t-RNA. A linker containing an amide bond is formed (see pp. 757-758), producing a composition of the formula R-Linker-A-X in which the linker has an amide bond. Therefore, a holding of anticipation is required.

Because claims 1-3, 6-8, 10, 11 and 15 have been canceled, the rejection of these claims in the previous Office action is moot and is withdrawn. Because claim 107 has been amended to include the limitations of claim 108, the rejection of this claim in the previous Office action is moot and is withdrawn.

Double Patenting- Obviousness-type

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 35-39, 40-44, 46-51, 55, 56, 58, 64, 65-67 and 69-77 (withdrawn method claims) are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 47-52 of copending Application No. 11/194,110. Although the conflicting claims are not identical, because the claim language related to the linker is broader in the copending application, they are not patentably distinct from each other because the same methods (a method of determining the presence or amount of a mutant dehalogenase and a method of labeling a cell) are claimed in each application. In each method, the same mutant dehalogenase, whether or not it present inside a cell, is labeled with the same substrate. Nevertheless, these two sets of claims are not patentably distinct and would not have been restricted had they been filed in the same application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding copending Application No. 11/006,031, instant claims 107 and 109-120 are unpatentable over copending claims 1-5 and 7, and withdrawn method claims 35-39, 40-44, 46-51, 55, 56, 58, 64, 65-67 and 69-77 are unpatentable over copending method claims 35, 36, 38, 45-47, 49, 56-59, 78-80, 116, 138 and 139. These two sets of claims are not patentably distinct, and the corresponding products and the methods would not have been restricted had they been filed in the same application. Nevertheless, in the copending application, Applicants have filed a Terminal Disclaimer in connection with the instant application. Accordingly, an obviousness-type double patenting rejection is not warranted here.

In reply to Applicants' remarks, Applicants are correct that claim 109 is an independent claim; it does not depend from claim 107. Accordingly, claim 109 has been rejected above.

The pending claims still contain undefined terms beyond those addressed in previous Office action, as indicated above. Thus, the pending claims are not allowable and are rejected above.

Regarding rejoinder of the withdrawn claims that have not been canceled, claims 35-39, 47-51, 55, 56, 58, 64, 67 and 69-77 would be eligible for rejoinder under the doctrine of In re: Ochiai if these claims were amended to delete the word "divalent," and if these claims were amended to delete dependency from claim 40 where such is present. Claims 65 and 66 would be eligible for rejoinder if claim 65 were amended to recite that the mutant dehalogenase is part of a fusion protein that also comprises a protein of interest. The current language is confusing, as the mutant dehalogenase and the protein of interest are two different proteins. Claims 40-44 and 46 will not be rejoined, because the steps do not recite a clear, coherent method. Claim 40 recites a method of isolating a molecule, cell or organelle in a sample by contacting the sample with a fusion protein comprising a mutant dehalogenase and a labeled substrate to which the

mutant dehalogenase binds, and then isolating the molecule, cell or organelle. The two steps are not related, and the first does not appear to be necessary for the second. Further, this method recites a method of isolating something by isolating it. No isolation steps are recited. Cancellation of these claims would expedite allowance of the potentially allowable claims.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosanne Kosson whose telephone number is 571-272-2923. The examiner can normally be reached on Monday-Friday, 8:30-6:00, with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber, can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rosanne Kosson
Examiner, Art Unit 1653

rk/2006-07-25

Rosanne Kosson

ROBERT A. WAX
PRIMARY EXAMINER